

Remarks

The above-referenced application has been reviewed in light of the Examiner's Final Office Action dated March 2, 2006, and further in light of the Examiner's Advisory Action dated May 26, 2006. Claims 17-22 have been amended, and new Claims 26-28 have been added. Therefore, Claims 17-28 are currently pending in this application.

In accordance with the Office Action, Claims 17, 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,526,438 to Bienvenu et al. in view of U.S. Patent No. 6,654,754 to Knauff et al. Claims 17, 20 and 22 have been amended.

Amended Claim 17 recites, *inter alia*, a "system ... comprising: a data manager, for storing restricted information for a first set of subscribers, partial restricted information for a second set of subscribers, and metadata describing the restricted information for non-subscribers and search engine robots; a transmission source determiner ... and a response unit ... wherein the **metadata comprises** an automatically generated **statement describing the subject matter and type of the restricted information**, a **keyword indicative of the content** of the restricted information for preparing a search engine keyword index, **and subscription information** describing how to join at least one of the first set of subscribers or the second set of subscribers" (**emphasis** added). Support for amended Claim 17 may be found in the specification as originally filed (see, e.g., Application at page 4, line 30 to page 5, line 3; page 20, lines 5-14). No new matter has been added.

The '438 to Bienvenu et al. is generally directed towards distributing information from a central database over a network to local file servers of current network subscribers. In Bienvenu, the network subscribers have local file servers, which contain previously distributed information (see Bienvenu at Abstract). When new or undistributed information is added to the central database, an entitlement table is updated to permit only current subscribers to receive the new information (*Id.*). Thus, Bienvenu makes no attempt to provide metadata including a "statement describing the subject matter and type of the restricted information, a keyword indicative of the content ... and subscription information", such as Applicants' do, to non-subscribers other than the full version of the previously distributed information that was already received by the local file servers of former subscribers when their accounts were current. Thus, Bienvenu fails to recognize the utility of, much less teach or suggest, the same type of metadata currently recited in amended Claim 17.

The '754 to Knaft et al. is generally directed towards dynamically generating an electronic document based, in part, on data analysis of a data object. Upon receiving a network request for a particular data object stored on the Knaft server, the system of Knaft dynamically generates an electronic document having index information relating to the data object (see Knaft at Abstract). Thus, the dynamically generated index information of Knaft is responsive to the network request. Thus, Knaft fails to cure at least the above-described deficiencies of Bienvenu with respect to metadata including a "statement describing the subject matter and type of the restricted information, a keyword indicative of the content ... and subscription information", as recited in amended Claim 17.

Thus, amended Claim 17 is neither taught nor suggested by the '438 to Bienvenu et al. in view of the '754 to Knauft et al. Similarly, amended Claims 20 and 22, which each recite similar features, are likewise neither taught nor suggested by Bienvenu in view of Knauft.

In accordance with the Office Action, Claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bienvenu and Knauft as applied to Claim 17 above, and further in view of U.S. Patent No. 6,694,365 to Wyngarden. Claims 18 and 19 have been amended.

The '365 to Wyngarden is generally directed towards receiving and providing access to information on a web site via password protection (see Wyngarden at Abstract). Wyngarden fails to cure at least the above-described deficiencies of Bienvenu with respect to metadata including a "statement describing the subject matter and type of the restricted information, a keyword indicative of the content ... and subscription information", as recited in amended Claim 17, from which amended Claims 18 and 19 depend.

In accordance with the Office Action, Claims 23-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bienvenu and Knauft as applied to Claim 22 above, and further in view of U.S. Patent No. 6,907,423 to Weil et al. Applicants intend to antedate the '423 patent to Weil et al. by providing a certified English translation of their foreign priority document when it becomes available, which priority document was filed on May 15, 2000.

U.S. Patent No. 6,907,423 to Weil et al. is generally directed towards controlling access of a local search engine to various local data collections. See,


e.g., Weil et al. at Abstract. Thus, some users may be registered on the local search engine of Weil in order to permit search of restricted collections. Weil makes no attempt to determine whether a given user is attempting to use a search robot to search Weil's local site since only Weil's own local search engine is permitted any access to the various collections. The identification of a given user is only used to determine which of Weil's local collections are to be searched by Weil's own local search engine. Therefore, Weil's system is inapposite to those of Bienvenu and Knauft.

Accordingly, Claims 23-25 are neither taught nor suggested by Bienvenu in view of Knauft, further in view of Weil, nor by any of the other references of record in this case. In addition, the Examiner's attention is drawn to new Claims 26-28, which each recite additional patentable subject matter.

Conclusion

Accordingly, it is respectfully submitted that independent Claims 17, 20 and 22-25 are in condition for allowance for at least the reasons stated above. Claims 18, 19, 21 and 26-28 each depend from one of the above independent claims, and necessarily include each of the elements and limitations thereof. Thus, it is respectfully submitted that these claims are also in condition for allowance for at least the reasons stated, as well as for reciting additional patentable subject matter. Therefore, each of Claims 17-28 is in condition for allowance. All issues raised by the Examiner having been addressed, reconsideration of the rejections and an early and favorable allowance of this case are earnestly solicited.

Respectfully Submitted,

 7/28/06
Eric M. Parham
Reg. No. 45,747
Attorney for Applicant

Correspondence Address:

F. CHAU & ASSOCIATES, LLC
130 Woodbury Road
Woodbury, New York 11797
Telephone: (516) 692-8888
Facsimile: (516) 692-8889